

printing means connected to said computer for printing said stored and retrieved agent coupon data in a format of an agent coupon.

~~Cancel~~ claim 16.

Claim 17. (Currently Amended) The apparatus of claim 15, wherein said software program means further includes means for identifying each generated agent coupon data.

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#### R E M A R K S

Claims 1-15 and 17-18 are pending in the application. Claim 15 and 17 have been amended, claim 16 has been cancelled.

The references cited in the July 9, 2003 mailing by Applicant and not considered by the Examiner have been properly included in this application by the filing of an information disclosure statement and listing the references on PTO form 1449.

Applicant respectfully acknowledges the Final Office Action of August 19, 2003 and the Examiners statements therein. In light of the amendment filed herein and the proper inclusions of the aforesaid references, and the argument herein, Applicant respectfully requests that the Examiner reconsider his final rejection of the Claims pending in the application

## THE ISSUE OF INVENTORSHIP

The Examiner is requested to reconsider his final rejection in consideration of the announcements made by ARC as reported in the references : the Travel Weekly News – Agent Issues, 6/20/2000, the Travel Weekly News – Agent Issues, 7/6/2000 and the ARC Group Meeting Minutes dated January 19, 2001 of the meeting held on November 2, 2000, in combination with Applicant's following comments with regard thereto.

In the ARC Group Meeting Minutes dated January 19, 2001 of the meeting held on November 2, 2000, it was stated:

In June 2000, ARC made an announcement that IAR agents can now print agent coupon on non-accountable stock or capture the coupon data on an optical media (i.e. CD-ROM, DVD etc.). In the long run, ARC will develop the ability to produce agent coupons on demand from ARC's data warehouse. The data warehouse will retain agent coupon data for two years as required by The Agent Reporting Agreement (ARA). However, agents should note that they might have other needs to maintain agent coupons for longer periods of time. In any case, storage of agent coupons will still be a recommended practice. ARC plans to charge a fee for the data warehouse services. Participants at the meeting requested ARC to provide CD-ROM storage of agent coupon on a monthly basis when the data warehouse becomes available.

Agents now have the option to pursue their own agent coupon storage solutions. However, such solutions need to be approved by ARC.....

In the Travel Weekly News – Agent Issues, 6/20/2000, it is stated:

ARC said travel agents who report their sales electronically can print the agent's coupons of each ticket on plain paper or capture the image on a CD-ROM or other optical storage media, effective immediately.

The ARC rule requiring the agents to retain agent's coupons for two years will remain in place

In the Travel Weekly News – Agent Issues, 7/6/2000, it is stated:

ARC previously announced that agents who report their sales electronically have the option of printing the agent's coupons of each ticket on nonaccountable paper or capture the image on optical storage media, effective immediately.

The new policy goals of ARC as announced in the above stated references were two fold: 1) to eliminate the need to print agent coupons on accountable stock , and 2) to capture the image of an agent coupon on optical media. Accordingly, the Examiner is requested to note that the former goal is not material to the present application, only the later is relevant.

In the amendment of July 9, 2003 Applicant attempted to distinguish the above quoted statements vis-a-vis Applicant's invention. On page 8 of the Final Office Action of 8/19/03, the Examiner "summarized" Applicant's attempt at distinguishing the same. However, it appears that the Examiner's "summary" is not in accordance with Applicant's intended remarks. Accordingly, Applicant will attempt to clarify his previous remarks to show that ARC did not invent Applicant's invention.

In order to more clearly claim his invention, Applicant amended Claim 1 to reflect that the data stored in Applicant's method is thereafter printed in a format of an agent coupon. Amended claim 1 provides for generating agent coupon data simultaneously with the printing of an airline ticket, electronically storing said data and then retrieving the data and printing it in the format of an agent coupon. Thus, amended claim 1 provides for the generating an agent coupon from the

stored data. ARC, statements on the other hand, are concerned with optically "capturing the image" of an agent coupon. It is respectfully submitted that there is a significant distinction between "capturing an image" and generating an image of an agent coupon. "Capturing an image" is akin to taking a photograph ; whereas generating an image is akin to a process for creating the photograph. That ARC's statements were directed to the actual capturing of an image is reflected in the revised Industry Agents' Handbook, Section 70.0, paragraph (4) where it is stated:

The records which are stored optically or on microfiche/film must be direct, complete, and accurate reproductions of the original sales reports, supporting documents and sales summaries and easily read and reproduced without loss of clarity....

Thus, it is clear that ARC imposed the requirement to store the agent coupon as a picture and not as data that is thereafter used to generate the agent coupon. That ARC did not invent Applicant's invention is further reflected in the statement by ARC that "If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database" (Travel Weekly News - Agent Issues, 6/20/00). That ARC did not have the capability to accomplish its own directorate is seen in the statement that ARC said that can give some advice but does not "provide the tools or systems" (Travel Weekly News - Agent Issues, 7/6/00). A further showing that ARC did not have the knowledge to implement its own policy, but rather it was a goal, is seen in the Travel Weekly News - Agent Issues, 6/20/00 "the option to switch the agent's coupons onto some sort of nonaccountable paper or media fits within two of ARC's long-term goals: ..." Even further, in the minutes of ARC' meeting of November 2, 2000 ARC admitted that its it did not have the knowledge or capability to produce agent coupons from stored data.

It is to be noted that ARC, on one occasion, used the word "data" with reference to producing an agent coupon, Meeting Minutes of November 2, 2000 meeting, page 2. Applicant noted the same on page 5 of the amendment of July 9, 2003. The Examiner noted the reference, but incorrectly attributed it to the Travel Weekly News - Agent Issues of 7/6/2000 and supplied emphasis to the same. On the other hand, ARC has on numerous other occasions, used the phrase "capture the image" as its new policy and stated that it was not to be construed as storing the coupon data. See, for example Travel Weekly News - Agent Issues of 6/20/2000 wherein it is stated three times to "capture the image" and wherein it is further stated "If you're printing, you need to print the same information that would be on the agent's coupon. We (sic) not talking about selecting data elements, we're talking about [using a different] media." And **"If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."** (Emphasis supplied). See also the Travel Weekly News - Agent Issues of 7/6/2000, wherein the phrase used is "...capturing the image on optical storage media,..." Thus, the clear intent of ARC's new policy was to capture an image of the agent coupon and not the data associated with an agent coupon.

That ARC did not invent Applicant's invention is further shown in the Travel Weekly News - Agent Issues of 7/6/2000, wherein it is stated "Unacceptable devices are computer hard drives, zip drives, floppy disks, magnetic tape and other magnetic media." (Referring, of course to capturing an image of the agent coupon).

Applicant amended his claims to reflect that the electronically stored data is used to subsequently print an agent coupon in the format of the agent coupon as it is presently known and used. While the above quoted references, and indeed all of the documents and handbook of ARC reflect that ARC will allow agents to

optically store agent data and optically capture the image of the agent coupon, neither ARC nor any others had the capability to create the agent coupon from the stored data. Certainly, data can be stored electronically. But only Applicant's invention is capable of creating an actual agent coupon from the stored data as disclosed and claimed by the Applicant.

Support for the above describe invention by the Applicant is clearly stated in the references cited by the Applicant. In the November meeting minutes ARC stated: "In the long run, ARC will develop the ability to produce agent coupons on demand from ARC's data warehouse." Thus as of November 2, 2000, ARC admitted that it did not have the capability to create agent coupons from agent data. Support for Applicant's inventive occurrence is also reflected in the fact that In the July 6, 2000 Travel Weekly News it was stated that ARC "does not provide the tools or systems" to capture the coupon image that it authorized as an option available to the travel agents. ARC could not then provide the tools or systems because it had not developed them.

The fact that ARC did not have the capability to store data from which agent coupons could be generated is also reflected in ARC's statement that "Agents now have the option to pursue their own agent coupon storage solutions. However, such solutions need to be approved by ARC." The storage solution ARC required was to "capture the image on optical media". The fact that Applicant was the first to invent the solution is reflected in the statement by ARC after Applicant submitted his inventive solution to ARC for its approval, which approval is stated in the January 19, 2001 memo to David Mitchell from Nancy Johnson.

The host document printer will be rerouted to a black box that resembles a CPU unit which will have two hard drives so it would be virtually impossible to lose information except of course, if someone disconnects the devices or there is a

system failure. The information from the agent coupon will be written to a protected CD-ROM. The agent information will be stored and will be accessible by record locator, name or ticket number. The agent coupons can be printed on demand and it is a facsimile of the agent coupon. (I will fax you both a copy of the printed agent coupon.) (Emphasis in the original)

It is therefore most apparent that the Applicant herein invented away from the dictates of ARC by using hard drives to store the data from which the actual image of the agent coupon is thereafter generated. Most importantly, Applicant's invention does not capture an image of the agent coupon, Applicant's invention creates a database which was expressly directed away from by ARC. **"If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database."** Travel Weekly News - Agent Issues of 6/20/2000, emphasis supplied.

Accordingly, it is respectfully requested that the Examiner withdraw his rejection under 35 U.S.C. § 102 (j).

#### THE ISSUE OF OBVIOUSNESS

The Examiner is requested to revisit his rejection based on obviousness under 35 U.S.C. § 103.

It is well accepted that hindsight may not be used to reject claims based on obviousness. It is also well accepted that the references on which a § 103 rejection is based must suggest the claimed invention. It is therefore necessary to determine what the reference suggests. There is absolutely no question that the ARC references do not suggest generating an agent coupon from stored data. In actual fact the ARC references unequivocally state that it is not acceptable to store

the data on an optical media, but rather the image must be captured on the optical media. The ARC references also unequivocally state that hard drives are not acceptable. Yet, Applicant's invention does precisely what ARC prohibits, let alone suggests.

One tool used to conclusively determine whether a § 103 rejection is applicable comprises the fact of the reference teaching away from the claimed invention. In the present case, there is little doubt that the Applicant's invention is directed away from the teaching of the ARC references. ARC's approval letter of Applicant's invention, dated January 19, 2001 is most telling in this regard. The emphasis supplied by the author, Nancy Johnson, i.e. "... it is a facsimile of the agent coupon." discloses ARC's amazement of the ability of Applicant's invention to generate the coupon image in a manner other than that envisioned by ARC in the many references cited by the Applicant.

In § 706.02 (m) of the MPEP, it is stated that,

The factual inquiries set forth in *Graham v. John Deere Co.* 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:

1. Determining the scope and contents of the prior art;
2. Ascertaining the differences between the prior art and the claims at issue; and,
3. Resolving the level of ordinary skill in the pertinent art,
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

Even prior to the *Graham v. John Deere* factors, a determination must be made as whether the cited prior art is analogous to the claims at issue. The test for the same is whether or not the reference in question is within the field of endeavor



of the applicant or patentee, *King Instrument Corp. v. Otari Corp.* 776 F.2d 853 (CAFC 1985); or, whether the reference is reasonably pertinent to the inventor's problem, *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.* 758 F.2d 613 (CAFC 1985).

In § 706.02(j) of the MPEP it is further stated that,

To establish a prime facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure.

*In re Vaeck*, 947 F.2d 488 (CAFC 1991).

The same section of the MPEP goes on to state that the initial burden is on the examiner to provide the suggestion of desirability of what the inventor has done or the examiner must present a convincing line of reasoning why the invention is obvious in light of the teaching of the references, citing *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985)

In the Final Office Action of July 19, 2003, the Examiner opines that there exist a wide variety of compression means to store images, graphics and textual documents in databases in attempting to explain that Applicant's methods and apparatus are obvious. However, the same is not Applicant's invention. As fully explained above, Applicant stores data (not an image, compressed or otherwise) and generates the agent coupon itself from the stored data. Moreover, the

Examiner merely concludes that Applicant's methods and apparatus used to accomplish the inventive objective is well known and used throughout the computer industry. The Examiner presents no concrete example of such "known format", instead, the Examiner presents an example of a using a known procedure of selling alcohol to adults to the selling alcohol to a minor after sales to a minor become legal. It is not a question of the legality (or authorization) of storing an image as compared to storing data from which an image can be generated because the same procedures are not used. ARC never suggested or even considered that it was possible to accomplish its goal to eliminate the hard copy of an agent coupon by storing data. That is why ARC was quoted in the Travel Weekly News (above) as emphatically stating "If you're printing, you need to print the same information that would be on the agent's coupon. We (sic) not talking about selecting data elements, we're talking about [using a different] media." And "If you're using a type of optical storage media, we're talking about capturing the image of the coupon, not creating a database." That is also why the approval of Applicants methods and apparatus by representative of ARC (Nancy Johnson) underscored the ability of Applicant's methods and apparatus to generate the agent coupon "... it is a facsimile of an agent coupon." Obviously then, there is no suggestion or motivation in any of the ARC references to accomplish ARC's goal in the manner being claimed by Applicant.

#### THE FRIEDES REFERENCE

With all respect, Applicant has not argued that "...Friedes does not disclose that the agent coupon is generated at the same time that an airline ticket is printed". In Applicant's amendment of July 9, 2003, Applicant stated "Also, there is no verbiage in Friedes regarding generating coupon data simultaneously with the printing of an airline ticket." Again, the distinction is data vis-à-vis an image.

As stated by Friedes, "More particularly, the present invention relates to mediating a transaction that uses a portable smart card and that employs a telecommunication network service" Thus, Friedes is not in the field of endeavor as Applicant's invention and is not at all concerned with the problem or the solution presented by Applicant. In the present application, the inventor's problem was the ability to generate an agent coupon from stored data that was initially recorded simultaneously with the printing of an airline ticket in a substantially foolproof manner in order to meet ARC's agent coupon storage requirements. Applicant's motivation was of course created by ARC's new goal; but, Arc's requirements do not form part of Applicant's claimed invention. Accordingly, It is respectfully submitted that the Friedes reference cited by the Examiner is not analogous art.

Here again, perhaps Applicant did not clearly present his argument as to why Friedes does not render obvious Applicant's invention under 35 U.S.C. § 103. To better understand the Friedes invention reference is made to the examples stated by Friedes where his invention can be advantageously used. Friedes states that his invention eliminates the need to print an airline ticket. The holder of a smart card calls an 800 number and inserts his card into a reader which connects the traveler to an airline agent (col. 6, lines 52-58). Based on the data read from the smart card, the travel agent telephonically calls the traveler (col. 6, lines 58-67). During the conversion, an airline ticket is purchased (col. 6, line 67, col. 7, line 1). The airline ticket data is transferred to the smart card (col. 7, lines 1-5). At the airport, the traveler presents the smart card which is inserted into a reader and the airline ticket data is verified. No airline ticket is generated -- only information or flight data is read (col. 7, lines 6-9). As stated by Friedes, "...the present invention eliminates the need to for a ticket in the form of a separate document or piece of paper ..." (col. 7, lines 9-12). Thus, Friedes does not "print"

an airline ticket as argued by the Examiner. Rather Friedes provides only for the reading of ticket information but not in the form of an actual airline ticket. Further, it is incorrect to argue that it would be a simple matter to print the airline ticket from the smart card because there is no suggestion or motivation to do so being disclosed by Friedes (his object is to eliminate the ticket per se) and Friedes invention can only provide for printing of the flight information or flight data as data and not in the form of an airline ticket. Thus, Friedes does not at all disclose or suggest that an actual airline ticket in the form of a standard airline ticket can be generated from the smart card.

#### THE ISSUE OF OBVIOUSNESS IN VIEW OF FRIEDES AND ARC'S HANDBOOK AND OTHER REFERENCES

The combination of Friedes and ARC's handbook and other references, do not render obvious Applicant's invention as stated by The Examiner. As noted above, ARC stated goal is to capture the image of an agent coupon and not merely create a database of information. Friedes is concerned with eliminating an airline ticket completely and stores only data on a smart card. No image is stored or suggested by Friedes because it would defeat the entire thrust of his invention. Conversely, storage of data as taught by Friedes would be contrary to the disclosures of ARC in being able to thereafter generate an image of an agent coupon with all of the pertinent data thereon. Therefore, a combination of the teachings and disclosures of ARC and Friedes would not result in Applicant's invention comprising the storage of data from which the known format of an agent coupon can be generated. The only way Applicants invention can be considered obvious is by employing the forbidden act of hindsight.

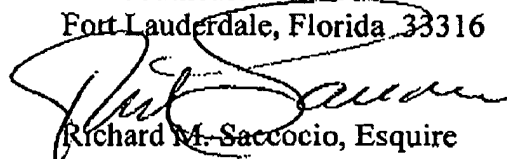
Accordingly, it is respectively requested that the Examiner's rejection under 35 U.S.C. § 103 based on Friedes in view of the ARC references be withdrawn.

### CONCLUSION

Having fully responded to the office action of August 19, 2003, it is submitted that the application is in a form for allowance, which action is respectively requested.

Respectively submitted,

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